



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,917	01/11/2001	Ashok Tehim	T8466360US3	9294

7590 03/12/2003
Carolyn S. Elmore
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
Two Militia Drive
Lexington, MA 02421-4799

EXAMINER

HUANG, EVELYN MEI

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/758,917

Applicant(s)

TEHIM ET AL.

Examiner

Evelyn Huang

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

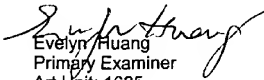
Claim(s) allowed: _____.

Claim(s) objected to: Z.

Claim(s) rejected: 1-6 and 9-13.

Claim(s) withdrawn from consideration: 14-19.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Evelyn Huang
Primary Examiner
Art Unit: 1625

Attachment to Advisory Action

1. Applicant requests that claims 14-19 be considered as they are drawn to a single inventive concept. On the contrary, the application contains claims to more than one of the combination of categories of invention since it contains 6 different alternative processes of use. The restriction as indicated is therefore improper.
2. The amended claim 1 would be rejected under 112 first paragraph because the compound in proviso (ii), i.e. the compound wherein when R3 is nitro, R1 is benzyl is not described in the specification.
3. The deletion of the prior art compound of Costi as in the amended claim 1 would overcome the 102(b) rejection over Costi.
4. The provisionally obviousness-type double patenting over the corresponding claims of copending Application No. 09/457606 is now obviousness-type double patenting over US Patent No. 6492380. Applicant maintains that the present amendment has set a demarcation from the allowed claims of the patent. The method claims in the patent are species within the instant generic method claim, wherein R1 is loweralkyl carbonate (a definition of which is not found the specification, but compound of R1 being acetic acid is described as preferred embodiment on page 9 of the specification)
5. The amendment would obviate the 103(a) rejection over Brana (4204063) since the compound, 1,3-dioxo-5-nitro-N-propylmorpholino-1,2,3,4-tetrahydrobenzo[I]-isoquinoline, has been deleted from the amended claim 5.
6. The amendment would overcome the 103(a) rejection over Sestanj I (3821383, PTO-1449) since the ethyl ester of 5-nitro- 1,3-dioxo-1H-benz[de]isoquinoline-2(H)-acetic acid has been excluded from the amended claim 5

Art Unit: 1625

7. The rejection for Claims 1-6, 9-12 under 35 U.S.C. 103(a) as being unpatentable over Sestanj I (3821383, PTO-1449) in view of Malizia (EP 206322, PTO-1449) would be maintained for amended claims 1-3, 9-12 because the compound in the amended claims wherein R1 is loweralkyl carbonate still encompasses the prior art compound wherein R1 is acetic or propionic acid.

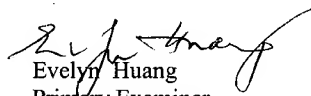
8. The rejection for Claim 13 under 35 U.S.C. 103(a) as being unpatentable over Sestanj I (3821383, PTO-1449) in view of Malizia (EP 206322, PTO-1449) and further in view of Bundgaard would be obviated by the deletion of 3-nitro-1,8-(N-propioncarboxylate) succinamidonaphthalene from the amended claim 13. However, further consideration/search may be required in view of the amendment.

9. The rejection for Claim 5, 6 are under 35 U.S.C. 112, second paragraph would be maintained because some of the compounds, such as the 4th, 5th, 8th compound of amended claim 5 and the 3rd and 4th compound of the amended claim 6, have no antecedent basis in the base claims 1 and 2 respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Evelyn Huang
Primary Examiner
Art Unit 1625

March 7, 2003